

Amendments to the Drawings

The attached sheet of drawings includes changes to Figure 3. This sheet, which includes Figure 3 only, replaces the original sheet including the same figure.

In the figure as submitted, the equation for calculating the "Subscription fee" in "Example 1", entered as " $75 \times \$95 = \$7,125$ ", was mistyped. The proper equation to calculate the Subscription fee should be the same as that shown in Example 2. That is, the correct equation is the amount of subscription fee (\$6,650) plus the product of the number of partners exceeding the collaboration community size (70) and the additional partner /month fee (\$95/ea).

Thus, in the present drawing amendment, the equation for calculating the Subscription fee in Example 1 of FIG. 3 is amended to read " $\$6,650 + (5 \times \$95) = \$7,125$ ".

REMARKS

Claims 38-42, 44-46, 48-51, 56-60, 62-69, 71-75 and 78-97 are pending in the case. In the final office action mailed July 1, 2005, all claims stand rejected. This is a reply to the final office action submitted with a Request for Continued Examination. In the present submission, claims 39, 58, 60, 73, 84 and 88-97 have been cancelled, claims 38, 40-42, 44-46, 48, 50-51, 57, 59, 62-65, 67-69, 71-72, 75, 78-81 and 85-86 have been amended, and new claims 98-111 have been added. Claims 1-37, 43, 47, 52-55, 61, 70, 76-77 have been previously cancelled. Applicant has also amended the specification and the drawing to correct typographical errors. Reconsideration is respectfully requested.

Drawing and Specification Amendments

FIG. 3 has been amended to correct a typographical error in the formula for calculating the subscription fee in Example 1 of the figure. As shown in the "Service Provider's subscription plan" in FIG. 3, when plan B is selected, the client pays the subscription fee of \$6,650 and then pays \$95 for each partner exceeding 70. The total subscription fee is \$7,125. The specification has been amended to correct typographical error and to conform the description to FIG. 3.

§112 Rejections

Claims 59-60, 62-69, 71-75, 78-89 and 95-97 have been rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enable requirement. The Examiner contends that the independent apparatus claims 59 and 95 "do not recite any structural elements of the claimed system." (See Office action p. 2.) In the present submission, claims 60, 73, 84, 88-89 and 95-97 have been cancelled and the rejection as to these claims is therefore moot. Applicant respectfully traverses the rejections.

With regard to claim 59, the claim has been amended to recite "an executable enterprise solution, implemented in an Internet enabled system" (emphasis added). Furthermore, claim 59 has been previously amended to recite "[a]n online system for a service provider to enable cost-sharing of a host subscription fee for a client's use of a hosted enterprise solution in an online collaboration community in which the client and its collaboration partners communicate among themselves online" (emphasis added).

Applicant's specification describes that the executable enterprise solution of the claimed invention is implemented and used with enterprise solutions that run on the Internet. For example, see page 1, lines 10-14, page 3, lines 5-7, and page 4, lines 17-21, of Applicant's specification. Furthermore, Applicant's specification describes an "online solution" as "[a]n enterprise application that runs and executes on the Internet" (page 2, line 6).

Claim 59, as amended, recites an *online system* including an executable enterprise solution that is implemented on an *Internet-enabled system*. Therefore, Applicant submits that claim 59, as amended, recites claim limitations that provide sufficient structural elements to meet the requirements of §112, first paragraph. Claims 62-69, 71-72, 74-75, 78-83 and 85-87, dependent upon claim 59, also meet the requirements of §112, first paragraph, for the same reasons as the base claim 59.

Claims 40-41 and 62-63 have been rejected under 35 U.S.C. §112, second paragraph, for being indefinite because the step of "enabling" in these claims is unclear. In the present submission, claims 40-41 and 62-63 have been amended to clarify the claim. Applicant submits that claims 40-41 and 62-63, as amended, now meet the requirements under §112, second paragraph.

For the above reasons, the claims currently presented meet the requirement under §112. Withdrawal of the §112 rejections of the present claims is respectfully requested.

§101 Rejections

Claims 59-60, 62-69, 71-75, 78-89 and 95-97 have been rejected under 35 U.S.C. §101 because the claimed invention is not directed to non-statutory subject matter. The Examiner contends that the claimed invention is not within the technological arts (See Office action p. 3.) In the present submission, claims 60, 73, 84, 88-89 and 95-97 have been cancelled and the rejection as to these claims is therefore moot. Applicant respectfully traverses the rejections.

As discussed above, claim 59 has been amended to recite "an executable enterprise solution, implemented in an Internet enabled system" (emphasis added). Claim 59 now recites an *online system* including an executable enterprise solution that is implemented on an

Internet-enabled system. As such, Applicant submits that claim 59, as amended, recites the technology – the Internet – that is used to implement the claimed invention. The recitation of an “Internet-enabled system” is a limitation in the technological arts and claim 59, as amended, is therefore directed to a statutory subject matter under §101.

For the above reasons, claim 59 and its associated dependent claims 62-69, 71-72, 74-75, 78-83 and 85-87 recite statutory subject matter meeting the requirements of §101. Withdrawal of the §101 rejections to these claims is respectfully requested.

§103 Rejections

Claims 38-42, 44-46, 48-51, 56-60, 62-69, 71-75 and 78-97 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Shorter (U.S. 2002/0198782). The Examiner contends that Shorter, describing a method and system for long-term customer retention by apply an incentive on a monthly, on-going basis, recites all the limitations of the rejected claims. (See Office action, pp. 7-9.) In the present submission, claims 39, 58, 60, 73, 84 and 88-97 have been cancelled and the rejection as to these claims is therefore moot. Applicant respectfully traverses the rejections.

Shorter describes a system and method for reducing turnover among subscribers to a service offered by a service provider. (See Abstract of Shorter.) Specifically, Shorter describes a system and method where a user enrolled as a member of a customer network having to pay a predetermined basic monthly service cost. The user may refer others to become subscribers. The system and method operates by “implementing a data base of service provider subscribers that indicates an association between each member and the member's referral subscribers, calculating a service credit for the member based upon activity of the referral subscribers, and applying the service credit to offset the member's predetermined basic monthly service cost.” (See Shorter, paragraphs [0015] and [0034].) In sum, Shorter describes a system and method where a user may reduce his/her monthly service cost for the use of the provider's service by referring others to become subscribers of the same service.

Under the scheme proposed by Shorter, only subscribers (the original subscriber and the referral subscribers) may utilize the service (such as a wire communication service) provided by the service provider. A person who does not subscribe will not be

able to use the service provided by the service provider. This feature of Shorter is made particularly clear in the original provisional application submitted by Shorter, of which the Examiner relied on for priority to render Shorter a proper prior art reference over the present application. In the original provisional application submission (a copy of which is enclosed), Shorter describes a "hierarchical network structure" where "[s]ponsors earn reasonable commissions on consumer and distributor sales...to cover the sponsor's cost of service from a service provider." Thus, Shorter's scheme requires the downstream consumers/distributors to subscribe to the service so that "a network of sales volume" can be generated to cover the sponsor's own cost of service.

After the present amendment, only two independent claims 38 and 59 remain. Applicant submits that claims 38 and 59, as presently amended, are patentable over Shorter for the following reasons.

Claim 38

Claim 38, as amended, recites:

38. A method for a service provider to enable cost-sharing of a host subscription fee for a client's use of a hosted enterprise solution in a collaboration community...comprising:

through the use of network enabled systems, executing an enterprise application to perform steps of:

...

tracking each partner in the collaboration community who pays a subscriber subscription fee for the partner's use of the hosted enterprise solution as part of being in the collaboration community, the partner paying the subscriber subscription fee becoming a subscriber of the hosted enterprise solution;

determining a value based on applying a predetermined function to the subscriber subscription fee paid by one or more partners, wherein the value indicates a modification to the host subscription fee for the client for using the hosted enterprise solution;

tracking each partner in the collaboration community who uses the hosted enterprise solution as part of being in the collaboration community but is not obliged to pay the subscriber subscription fee for the partner's own use of the hosted enterprise solution and thereby does not contribute to the value; and

updating relevant information that affects the client's host subscription fee based at least in part on the value. (Emphasis added.)

Claim 38, as amended, is patentable over Shorter at least by reciting "tracking each partner in the collaboration community who uses the hosted enterprise solution as part of being in the collaboration community but is not obliged to pay the subscriber subscription fee for the partner's own use of the hosted enterprise solution and thereby does not contribute to the value." In the claimed method of claim 38, the client pays a host subscription fee for the client's use of the hosted enterprise solution for communicating with its collaboration partners. While the client may invite one or more of its collaboration partners to become subscribers and thereby receives a reduction in the client's host subscription fee, the client may continue to communicate with all of its collaboration partners regardless of whether the partners are subscribers. Therefore, in the claimed method of claim 38, the client's collaboration community includes a partner who *"uses the hosted enterprise solution as part of being in the collaboration community but is not obliged to pay the subscriber subscription fee for the partner's own use of the hosted enterprise solution."*

Shorter does not teach or suggest at least this limitation of claim 38. A "sponsor" in Shorter (see provisional application submission of Shorter) may receive a reduction in his cost of service by referring the service to others who eventually subscribe to the service. However, Shorter does not teach or suggest allowing a *non-subscriber* to *use* the service provided by the service provider to communicate with the "sponsor". Claim 38 is distinguishable over Shorter in part because in the claimed method of claim 38, a client pays a host subscription fee for using a hosted enterprise solution to communicate with its collaboration partners who may or may not be subscribers. While the client does not derive a fee reduction benefit from a partner who is a non-subscriber, the client and the non-subscriber partner are able to continue to communicate using the hosted enterprise solution. For the reasons stated above, claim 38 is patentable over Shorter.

Claims 40-42, 44-46, 48-51 and 56-57

Claims 40-42, 44-46, 48-51 and 56-57, dependent upon claim 38, are patentable at least for the same reasons that claim 38 is patentable.